

searches. However, the application was filed as a national stage application under 35 U.S.C. § 371. Therefore, the “unity of invention” rules adopted under the Patent Cooperation Treaty (PCT) apply.

Applicable rule 13.2 PCT states:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 [PCT] shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Applicants respectfully submit that all the claims share a “technical relationship.” In this case, the methods, antibodies, nucleic acids, and compositions claimed all relate to restoring p53 transactivation. This “special technical feature” defines a contribution that the claims, when taken as a whole, make over the “prior art.”

The mere fact that the words "antibody," "nucleic acid," and "method" appear in different claims does not mean that distinct inventions exist or that a separate inventive concept is at issue. An analysis of the inventive concept should not be limited to a consideration of how an element of the claims can be used, or what the element of the claims are. Such an analysis fails to consider whether a common “technical feature” actually exists.

According to 37 C.F.R. § 1.475, a national stage application will possess unity of invention if the claims combine a product, a process of manufacture of the product, and a use of the product. Here, the compositions, antibodies, and nucleic acids share the common technical feature noted above. The method claims encompass the use of these products. This combination of claims is considered within the noted “unity of invention” standard.

Furthermore, Rule 13.4 PCT states that:

Subject to Rule 13.1 it shall be permitted to include . . . dependent claims, claiming specific forms of the invention claimed in an independent claim, even where the features of a dependent claim could be considered as constituting in themselves an invention.

This Rule would seem to apply here because all of the claims specifically or inherently possess the common feature noted above. Even if the dependent claims add additional inventive features, that itself is not a reason to separate the application.

All of these reasons support the conclusion that all the claims share a single general inventive concept as described in Rule 13.1 PCT and that the claims satisfy the requirement of unity of invention. Therefore, Applicants respectfully submit that a restriction requirement is not necessary.


If there are any fees due with the filing of this response, please charge the undersigned's Deposit Account No. 02-0375. If an extension of time or petition is required to consider this response, applicants hereby petition the Commissioner and the undersigned representative authorizes that any required fees, including fees for net addition of claims, be charged to Deposit Account No. 02-0375.

Respectfully submitted,

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